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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,782	08/06/2001	Niels C. Holch	08339.0002-05000	7805

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EXAMINER

HARRISON, JESSICA

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,782

Applicant(s)

HOLCH ET AL.

Examiner

Jessica J. Harrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-157 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-157 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on filing is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This application is a continuation of prior application Ser. No. 08/877,375. Three preliminary amendments have been received and entered. A Terminal Disclaimer has been received, is proper, and has been recorded. Claims 1-52 have been cancelled. Claims 53 – 157 are pending.

Specification

The amendments filed 8/30/2002 and 2/3/2003 are objected to under 35 U.S.C. 132 because each introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: In the amendment of 8/30/2003, the first paragraph remaining states “ an interface to receive, ..., game information on a per-game basis, and a processor for adjusting the player account balances on a per game basis”. In the next paragraph, applicant has added “game information may be received ...every time a wager amount is received...”. These recitations enlarge the scope of that which was previously disclosed.

The prior application, which matured into US Patent 6,280,328 states that both the game information (as defined herein) and the game results are sent to the account server after game play. Col8:18 – 26 and Fig5b step 542. While “after” each game is “per-game”, per-game clearly encompasses during the game and prior to the game, possibilities which clearly are not encompassed by the prior disclosure. It is noted that the prior application

disclosed an account validation prior to game play, as well as an account determination of sufficient funds. However, no disclosure is seen as to what information is involved in these steps (presumably at best a player ID and a wager amount) ; since the broadly defined "game information" encompasses the "resulting account balance", such can not be sent "prior" to the wager and game. The prior disclosure does state the account balances in the terminal and central are monitored on a "per-game" basis (to detect fraud as early as possible) and that "activity information" is sent in "real time" and that "tracking of player activity on a per-game basis helps tailor player terminals". "Activity information" is separately defined from "game information". This, however, is not the same as sending/receiving "game information" (as defined by applicant) every time a wager is received or on a "per-game" basis.

The amendment of 2/3/2003 added new matter with the language "a game terminal number" and "result of the game" in the listing of game information. The prior application-listed the result of the game as separate information from "game information" and described the terminal number as being a "player terminal number".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

Claims 67-72, 80-86, 87-92, 93 – 97, 98-102, 112 – 114, 119 – 121, 143 – 150, 155 and 157 are rejected under 35 U.S.C. 112, first paragraph, as

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failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims recite transmitting game information or updating account information on a per-game basis, or the transmission of game information for each wager received. This language constitutes new matter as described hereinabove.

Claims 57, 64, 72, 77, 84, 92, 94, 99, 104, 107, 110, 113, 117, 120, 123, 138 and 157 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims all recited "game terminal number" rather than player terminal number. It is not known what game terminal number is; therefore the claim recites new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 127, 132, 153 and 154 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly

claim the subject matter which applicant regards as the invention. In claims 127 and 132, it is not clear how the game terminal can include a game server. These are structurally distinct components. Claims 153 and 154 lack antecedent basis for "the calculations".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 53 – 59, 60 – 66, 67-72, 80-86, 151, 152, 87-92, 93 – 97, 106-108, 112-114, 119, 121, 122, 123, 145-150, 155-157 are rejected under 35 U.S.C. 102(b) as being anticipated by Hedges et al. (4,467,424). Hedges discloses a remote gaming system which enables player's participation in selected wagering games from a remote terminal 10. The system includes a player terminal 10 which has at least touch input means, display means and ID/Account card reading means as well as software to execute the terminal functions and display. The system also includes a central controller 9 (called

the credit station) and a croupier station where random numbers are generated. Given the number of claims presented, and that the claims differ only slightly in scope and variation of language, an exhaustive listing of each claim with respect to Hedges is not being made. The interpretations of Hedges in light of the claim language will be discussed while limitations in the instant claims not discussed hereinbelow are deemed to be readily apparent from a reading of Hedges. The claimed "means to transmit game information for each game" is taught at Hedges 13:11-12 and 13:36-37. The claimed "means for executing application program in response to an externally generated random number" is Hedges display processing application program, which executes in response to the random numbers generated at the croupier station (external) in order to display the game results to the player. The claimed "means for adjusting the account after a game" is taught in Hedges at 13:61, 62 – the central updates the account after the game. Player identification is transmitted in the activation step taught in col 12 of Hedges. As for the claimed game information – Hedges transmits the game selection and the wager amount, at least. Hedges terminals do not use money. Hedges central credits upon game win, and debits upon game loss, after each game. Hedges encompasses a "terminal", a "central", a "system", and as he is operated with a combination of hardware and software, Hedges includes "a computer-readable medium containing instructions for causing a computer to perform a method of

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operating gaming systems..." as claimed. Hedges is deemed to meet the claims as broadly claimed.

Claims 73 – 79, 103-105, 109-111, 115-118, 124, 127, 129, 130, 132, 134, 136, 138, 139, 141, 143 and 144 are rejected under 35 U.S.C. 102(e) as being anticipated by Franchi (5,770,533). These claims share the feature of the transmission of game information to the central from the terminal after a game is played. Franchi includes a plurality of remote game terminals and a central computer. Game choices and amounts wagered are entered at player terminals. Game results are determined, displayed, and transmitted to the central which maintains player account balances additionally to those stored on the card. See 6:30- 36 and 7:30 – 45, at least. See also step 306 of Figure 3 where both balances are checked as a security feature. The reference is deemed to meet the claims as broadly claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 126, 128, 131, 133, 135, 137, 140, and 142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franchi. Franchi's random numbers used for game play appear to be generated internally of the terminal, or externally (use of Franchi with actual cards or table games) but not from the central or from a random number server. However, computer generation of random numbers is notoriously old and well known and capable of instant demonstration. Use of computerized RNG's in a gaming environment has been popularized in that it appears safer to some players who may think a dealer will cheat them. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement Franchi with games utilizing computer generated random numbers, particularly generated centrally, so that players may perceive the game is fair.

Claims 120, 153 and 154 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedges in view of Franchi.

Hedges fails to send the game information from the terminal to the central as recited in claim 120, and to check balances for security reasons as recited in claims 153, 154. Both of these are done in Franchi, in order to enhance security. It would have been obvious to one of ordinary skill in the art at the time of the invention to update the central after each game, to maintain duplicate balances and to compare balance calculations in Hedges as is done in Franchi, in order to provide a secure game system desirably taught by Franchi.

Response to Amendment

It is noted that in applicant's Remarks submitted February 3, 2003 applicant attempts to set forth why applicant considers the "per game" language is not considered new matter. Applicant notes that game information is not limited to "after" each game, and then provides a "wager amount" as an example. Respectfully, the fact that one element listed as game information may also be sent prior to the game does not support all elements listed as being transmitted prior. And as noted above, player activity information is defined differently from game information.

Applicant' continues to assert his amendments do not change the inventions patentability over the prior art. Clearly, based upon the above rejections, the examiner disagrees. Applicant states that Hedges does not disclose "means for executing...externally generated random number". Clearly Hedges does. Applicant has broadened the claims substantially from that which was previously found allowable. Curiously, applicant then argues that the prior art does not teach transmitting game information *after each game* as recited. The examiner ponders why applicant argues his disclosure is not limited to "after each game" and broadening to on a "per-game" basis does not constitute new matter on one page yet argues that he is limited to "after each game" in order to distinguish over prior art on the next page? Nonetheless, Applicant has broadened the claims such that transmitting is no longer

claimed in the majority of the claims. They merely recite the account is updated after the game, and Hedges clearly anticipates such.

Information Disclosure Statement

Applicant's IDS of 1/4/ 2002 is noted. The parent files have been reviewed, and copies of prior art readily available to the examiner or contained within the parent files have been initialed considered. However, it is noted that the parent files do not appear to contain all non-patent literature listed on applicant's 1449. Applicant should submit copies of all non-initialed prior art listings so that the instant examiner may fully consider this prior art.

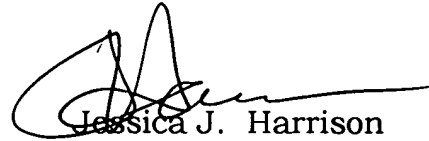
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica J. Harrison whose telephone number is 703-308-2217. The examiner can normally be reached on 8 hour/M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

A handwritten signature in black ink, appearing to read 'Jessica J. Harrison', is written over the printed name.

Jessica J. Harrison
Primary Examiner
Art Unit 3714

jjh
August 11, 2003